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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael Wengrovitz

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EXAMINER

RUTKOWSKI, JEFFREY M

ART UNIT

PAPER NUMBER

2473

MAIL DATE

DELIVERY MODE

11/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/741,306	Applicant(s) WENGROVITZ ET AL.	
	Examiner JEFFREY M. RUTKOWSKI	Art Unit 2473	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 6-12 have been cancelled.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/09/2009 has been entered.

Examiner's Note

2. Even though the claims do not recite term "means" since the phrase "logical IP set" is generic structural term that, standing alone, is synonymous with means and connotes no more structure than "means," the claims have been interpreted to invoke 112 6th paragraph.

Massachusetts Institute of Technology v. Abacus Software, 80 USPQ2d 1225 (Fed. Cir. 2006)

Claim Rejections - 35 USC § 112

The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-5** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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4. **Claims 1-5 and 13-19** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not adequately describe the structure that corresponds to the logical IP set. The specification only describes the functionality of the logical IP set but does not provide any structure that corresponds to the logical IP set.

5. **Claims 1-5 and 13-19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by a "...logical IP set..." in independent **claims 1 and 13**.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims **1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallant (US 2002/0131575) in view of Bhat et al. (US Pat 7,058,082), hereinafter referred to as Bhat, and the Admitted Prior Art, hereinafter referred to as the APA.

8. **Regarding claim 1**, Gallant teaches a server (see Fig. 4 Box 22) coupled to the voice switch (see Fig. 4 Box 14) and the network of one or more first devices (see Fig. 4 Box 18), the server maintaining for at least one of the first devices a logical device adhering to the first protocol (see Fig. 4 Box 22), the server further receiving media directed to the logical device and redirecting the media to the first device (see Fig. 4 Box 30).

Gallant does not disclose maintaining a logical IP set for each device. Bhat discloses an architecture where a separate state machine (logical entity) is maintained for each device that is involved in a call [**col. 25 lines 50-55, figure 25A**]. Bhat's basic call state machine **568** is essentially the same as the logical IP set because the basic call state machine **568** performs operations of a *physical IP* set by responding to events in protocol-based networks (see col. 21 lines 28-31). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use Bhat's state machines in Gallant's invention to maintain information pertaining to a call [**Bhat, col. 25 lines 25-27**].

The combination of Gallant and Bhat disclose maintaining a separate state machine for each device involved in a call. The combination of Gallant and Bhat does not disclose the use of IP sets. The APA discloses that IP sets are well-known in the art [**Specification, page 9 lines 19-23**]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use IP sets in Gallant's invention to make use of well established technology.

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9. **Regarding claim 2**, the combination of Gallant, Bhat and the APA disclose the use of IP sets. Gallant further teaches the server further translates media transmitted to the logical IP set according to the first protocol to media adhering to the second protocol (see paragraph 31 lines 16-18), the media adhering to the second protocol being redirected to the first device (see paragraph 34 lines 1-4).
10. **Regarding claim 3**, Gallant further teaches where the first protocol is a private signaling and voice protocol (see paragraph 30 lines 5-9).
11. **Regarding claim 4**, Gallant further teaches where the second protocol is a session initiation protocol (see paragraph 30 lines 5-9).
12. **Regarding claim 5**, the combination of Gallant, Bhat and the APA disclose the use of IP sets. Gallant further teaches the server stores a mapping of an address associated with the logical IP set with an address associated with the first device (see paragraph 34 lines 1-4).
13. Claims **13-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (US 2003/0093563) in view of Bhat and the APA.
14. **Regarding claim 13**, Young teaches receiving from the voice switch a first message indicative of a first communication port to be used by a particular device for receiving media (see paragraph 77 lines 1-5); receiving from the particular device a second message indicative of a second communication port to be used by the particular device for receiving media (see paragraph 76 lines 1-7); and reconciling a difference between the first communication port and the second communication port (see paragraph 80 lines 1-6).

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Young does not disclose maintaining a logical IP set for each device. Bhat discloses an architecture where a separate state machine (logical entity) is maintained for each device that is involved in a call [col. 25 lines 50-55, figure 25A]. Bhat's basic call state machine 568 is essentially the same as the logical IP set because the basic call state machine 568 performs operations of a *physical IP* set by responding to events in protocol-based networks (see col. 21 lines 28-31). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use Bhat's state machines in Young's invention to maintain information pertaining to a call [Bhat, col. 25 lines 25-27].

The combination of Young and Bhat disclose maintaining a separate state machine for each device involved in a call. The combination of Gallant and Bhat does not disclose the use of IP sets. The APA discloses that IP sets are well-known in the art [Specification, page 9 lines 19-23]. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use IP sets in Gallant's invention to make use of well established technology.

15. **Regarding claim 14**, Young further teaches mapping the first communication port to the second communication port (see paragraph 75 lines 7-12); receiving media addressed to the first communication port; and redirecting the media to the second communication port (see paragraph 75 lines 7-12).

16. **Regarding claim 15**, Young further teaches where the mapping statically allocates the first communication port to the second communication port (see paragraph 80 lines 1-7).

17. **Regarding claim 16**, Young further teaches where the mapping dynamically allocates the first communication port to the second communication port (see paragraph 80 lines 1-7).

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18. **Regarding claim 17**, Young further teaches translating media transmitted to the first communication port according to the first protocol to media adhering to the second protocol (see paragraph 82 lines 1-6), where the redirecting of the media comprises redirecting the media adhering to the second protocol to the second communication port (see paragraph 77 lines 1-5).

19. **Regarding claim 18**, Young further teaches where the first protocol is a private signaling and voice protocol (see paragraph 82 lines 1-6).

20. **Regarding claim 19**, Young further teaches where the second protocol is a session initiation protocol (see paragraph 82 lines 1-6).

Response to Arguments

21. The arguments with respect to the feature of the logical IP set being clear and enabling are not persuasive. The cited portion from page 10 of the specification does not describe the structure that corresponds to the logical IP set (see Applicant's reply, page 7). The cited portion only describes what the logical IP set does, which is an abstraction of a physical IP set. The CAFC has held that when an abstraction is claimed, there needs to be corresponding structure. *Blackboard Inc. v. Desire2Learn Inc.*, 91 USPQ2d 1481 (Fed. Cir. 2009) (insufficient structure to perform function of "assigning a level of access to and control of each data file based on a user of the system's predetermined role in a course," recited in means-plus-function limitation of asserted claims, and claims are therefore invalid for indefiniteness, since patentee argues that "access control manager" is structure that performs recited function, but what patent calls "access control manager" is merely abstraction that describes function of controlling access to course materials).

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22. The arguments with respect to Bhat's state machines not being the same as the logical IP set because Bhat's state machines do not perform operations such as firmware download and handshaking are not persuasive because this functionality is not required by the claims.

23. Applicant's arguments filed 09/09/2009 have been fully considered but they are not persuasive, for the reasons stated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY M. RUTKOWSKI whose telephone number is (571)270-1215. The examiner can normally be reached on Monday - Friday 7:30-5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kwang Yao can be reached on (571) 272-3182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey M Rutkowski/

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Examiner, Art Unit 2473

/KWANG B. YAO/

Supervisory Patent Examiner, Art Unit 2473